

III. REMARKS

In the Office Action, requirement was made to correct informalities appearing on the page of the Abstract, and to insert section headings in the specification. These corrections have been made by this response.

Claims 1-40 were rejected under double patenting over the subject matter of US patent 6,301,338 for reasons set forth in the Office Action. It is requested that the matter of double patenting be held in abeyance until the final wording of all of the claims has been determined.

Claims 1, 4-9, 12-13, 15-21 and 23-40 were rejected under 35 U.S.C. 102 as being anticipated by Wolff (US 5,327,486), and claim 14 was rejected under 35 U.S.C. 103 as being unpatentable over Wolff in view of Villa-Real (US 4,481,382) for reasons set forth in the Office Action.

Allowable subject matter has been noted in claims 2-3, 10-11 and 22.

The claims are believed to be allowable in their present form, and accordingly, the claims have not been amended further. The position of the Examiner is not understood, with respect to the rejected claims, because the claims contain limitations which

are believed to distinguish the subject matter of the claims from the teachings of Wolff and Wolff in view of Villa-Real.

The independent claims 1, 20-25, 29, 33 and 37 set forth the basic features of the present invention. The invention provides for the identification of a caller, the selection of the way of responding, and the action of sending a reply, and wherein these functions are all performed in a single device. This is the same device to which the call was originally directed and, as set forth in most of the independent claims, is a portable terminal. Also, as set forth in most of the independent claims, the single device (portable terminal) provides a selected response to a caller exclusively through the action of the portable terminal.

Contrary to the position of the Examiner, it is urged respectfully that Wolff does not teach the foregoing features of the present invention. Wolff requires always the use of at least two devices to accomplish his functions of intercepting an incoming telephone call, and establishing the appropriate handling of the call (such as a screening of the call, a storing of a message, and a transmission of a reply, by way of example). One of the two devices of Wolff is a fixed network-connected device. Even if the second device of Wolff were a portable terminal, the division of operational procedures in Wolff precludes the portable terminal from performing all of the actions. This contradicts the teaching of the present invention wherein the portable terminal performs all of the actions.

To emphasize the foregoing point, it is repeated that numerous ones of the present independent claims state that the single device (portable terminal) provides a selected response to a caller exclusively through the action of the portable terminal. The word "exclusively" excludes the use of the personal telephone manager (PTM) 12 of Wolff in combination with a portable terminal, and is understood to emphasize that all of the necessary actions for handling the incoming telephone call are performed by the portable terminal of the present invention without aid of other telephone equipment.

The foregoing distinctions between the present invention and the teaching of Wolff, considered individually or in combination with Villa-Real, become still though more apparent from a reading of the following passages in Wolff (column 3 at line 51 through column 4 at line 6). Upon receiving an incoming call, the PTM 12 reads and decodes automatic number identification information and consults an end user's personal database to translate the calling number information into the name of the caller. The PTM 12 then attempts to locate the end user and alert the end user of the incoming call after the calling party is first screened against a personal profile. At this point, the PTM 12 decides whether or not to put the telephone call through to the end user. The location of the end user is checked and, if the end user is available, then the call is transferred to the end user. But if the end user is not available, the calling party is put on hold.

It is noted that the foregoing functions are provided by the PTM, which is a part of the telephone system, and totally separate from the end device such as a portable terminal. Unless the Examiner wishes to regard the PTM and the end device of Wolff as a single element of the telephone system, it does not appear to be possible to regard the teaching of Wolff as anticipating the present invention or being suggestive of the present invention. It is urged that, upon a reading of the present specification, and an interpretation of the present claims in light of the teachings of the present specification, the use in the present invention of a portable terminal to accomplish all of the functions of handling an incoming telephone call without resort to the telephone company is certainly a distinguishing teaching of the present invention.

To demonstrate further that Wolff teaches away from the practice of the present invention, in particular, by requiring that the incoming call always comes to a PTM, which is a fixed device and sits at a location that is most likely distant from a portable terminal, the following textual passages of Wolff are analyzed.

Location in Wolff	Quotation	Explanation
Col. 3, lines 35-37	"a software application program called a personal telephone manager 12 (PTM) which runs on a computer platform 14"	Wolff requires there to be, at the disposal of the user, a software program that is responsible for managing the incoming calls.
Col. 3, lines 39-40	"and a palm-top computer 18"	The palm-top computer 18 is clearly a <i>different device</i> than the computer platform 14 where the PTM program is running.

Col. 3, lines 48-50	"A call to the end user is routed by the public local exchange network 10 to the platform 14 where it is processed by the PTM 12."	The call comes <i>to the computer platform 14</i> . It does <i>not</i> come to the palm-top computer 18.
Col. 3, lines 51-55	"the PTM 12 reads and decodes automatic number identification information at block 26 and consults the end user's personal data base to translate the calling number information into the name of the caller"	The caller is identified through the action of the PTM. Since the PTM is running in the computer platform 14 and not in the palm-top computer, it is <i>not</i> the palm-top computer that performs the identification.
Col. 3, lines 61-66	"The PTM 12 then attempts... If the decision is made not to make the connection, at block 28, the calling party is connected to voice mail or messaging at block 29."	Again it is the PTM that is operative. Connecting the calling party to voice mail or messaging takes place, when the call is <i>not</i> routed further from the PTM.
Col. 4, lines 7-8	"The PTM 12 delivers the caller's name and number to the end user's palm-top computer 18"	The PTM does <i>not</i> direct the <i>call</i> to the palm-top computer, obviously because the palm-top computer is not a telephone but a computer.
Col. 4, lines 11-24	"software in the PTM 12 constructs a data packet ...packet is sent to the RAM gateway...The RAM gateway...routes the message packet...The packet is then transmitted...alerts the palm-top computer 18 of the arrival of a packet"	A detailed explanation how only a data packet, which is certainly <i>not</i> a call, goes from the PTM to the palm-top computer. It is <i>very</i> important to note that while this is happening, the <i>call</i> is <i>on hold</i> at the PTM and not rerouted anywhere.
Col. 4, lines 38-42	"the palm-top based application program on the computer 18 displays the name and number of the caller to the end user, who can use the information to	The end user now knows that there is a call waiting at the PTM in his office. The call has <i>not</i> been routed to the palm-top computer. Only

	"decide how to respond to the call"	information about the known identity of the caller was sent to the palm-top computer, by using a data packet. The user now makes a decision how the call should be handled. Note that the palm-top computer did not have to identify the caller, firstly because the call never came to the palm-top computer and secondly because the caller had already been identified at the PTM, and a data packet therefrom brought the identity in a cleartext form to the palm-top computer.
Col. 4, lines 43-46	"the called party selects a desired response or reply message in response to prompts generated by the palm-top application program"	Decisions are now made between the palm-top computer and its user. The call is still on hold at the remote PTM, which is <i>not</i> running at the palm-top computer.
Col. 4, lines 47-51	"the called party transmits the response message back to the radio network 16 which, in turn, communicates the response message to the PTM 12."	The decision how to handle the call has been made, and corresponding instructions are transmitted from the palm-top computer to the PTM, where the call still is on hold.
Col. 5, lines 21-23	"When the reply packet is received by the PTM 12, the message is processed and the instructions of the end user are executed"	The PTM can now e.g. send a reply to the call. Note that it is the PTM and <i>not</i> any portable terminal that sends the reply in such a case. The palm-top computer did <i>not</i> send any replies. It only sent an instruction packet to the PTM,

		instructing the last-mentioned to send a reply.
Col. 7, lines 7-8	"the PTM 12 identifies the caller"	Again: it is the PTM that identifies, and the PTM is not a portable terminal.

A further matter may require clarification. The Examiner refers to Col. 7, lines 42-46, where the following text passage appears: "the palm-top computer 12 alerts the end user of an incoming call with an audible tone". This passage includes an unfortunate printing error, because of the total of sixteen occurrences of the term "palm-top computer" with a reference number in the Wolff patent, fifteen (!) are "palm-top computer 18" while this single one on line 43 of column 7 cites the reference number 12. Note also that on line 42 of column 7 Wolff says "as described above", which can only refer to column 4, line 34 ("issuing an alerting tone"). It is clear that the passage on lines 42-46 of column 7 describes the operation of what has also everywhere else in the application been denoted as the "palm-top computer". And, as shown earlier herein a number of times, such a palm-top computer of Wolff never gets a call routed thereto, and also never identifies any callers, both of which functions are claimed features in the present independent claims.

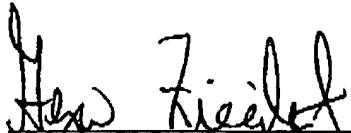
Again, it is emphasized that, the present invention as claimed describes operations that all take place in a portable terminal, while Wolff describes operations a part of which take place in a fixed network-connected device and only a part of which take place in a portable terminal. Also, insofar as the Examiner's position is understood, it appears that the Examiner has already acknowledged the difference between the invention and Wolff in

the parent application, based on the consideration that all actions are taken by the portable terminal. Therefore, and in view of the foregoing analysis and discussion, it appears that the foregoing argument has overcome the rejections under 35 U.S.C. 102 and 103 to secure allowance of all of the present claims.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza C. Ziegler, Jr.
Reg. No. 44,004

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

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